

REMARKS¹

In the Office Action, the Examiner took the following actions:

rejected claims 1-20 on the grounds of a nonstatutory obviousness-type double patenting rejection as being unpatentable over claims 1-14 of U.S. Patent No. 7,008,731 to Nojima et al. ("Nojima") in view of U.S. Patent No. 7,001,697 to Park et al. ("Park");

rejected claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,208,469 to Matsuura et al. ("Matsuura"); and

rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Matsuura in view of Park.

Claims 1-20 remain under examination.

Regarding the nonstatutory obviousness-type double patenting rejection

Applicants respectfully traverse the rejection of claims 1-20 on the grounds of a nonstatutory obviousness-type double patenting rejection as being unpatentable over Nojima in view of Park. Applicants respectfully disagree with the Examiner's conclusions at pages 2-3 of the Office Action regarding the combination of Nojima and Park. However, in order to advance prosecution of this application, Applicants submit the attached a terminal disclaimer as provided for under 37 CFR 1.321(c). Accordingly, Applicants respectfully request that the Examiner withdraw the rejection under a nonstatutory obviousness-type double patenting rejection.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Regarding the rejection under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by Matsuura. Matsuura fails to teach each and every element recited in, for example, independent claim 1.

In order to support a rejection under 35 U.S.C. § 102, each and every element of each claim in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites “[a] method for evaluating a photomask comprising . . . finding a dimensional variation . . . of the photo mask.” The Examiner acknowledges that Matsuura fails to teach a “method for evaluation a photomask.” Office Action at 5. Accordingly, Matsuura cannot teach “finding a dimensional variation . . . of the photo mask” also recited in claim 1 and therefore fails to teach each and every element recited in claim 1. Matsuura does not anticipate claim 1.

Independent claim 16, although of different scope, recites similar limitations to claim 1 and is therefore not anticipated by Matsuura for similar reasons as claim 1. Claims 2-15 and 17-20 depend from independent claims 1 and 16, respectively, and are allowable at least due to their respective dependence. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-20 under 35 U.S.C. § 102(b).

Regarding the rejection under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Matsuura in view of Park. No *prima facie* case of obviousness is established based on the combination of the references.

To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements. See M.P.E.P. § 2143. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 706.02(j). The combination of Matsuura and Park does not teach each and every element recited in claim 1.

Claim 1 recites *inter alia*:

finding a dimensional variation relating to [a] photo mask, the dimensional variation including first and second dimensional variations, the first dimensional variation occurring due to a positional displacement and size mismatch of the unit drawing pattern in the photo mask and the second dimensional variation occurring due to etching and development relating to a manufacturing of the photo mask.

As discussed above, the Examiner acknowledges that Matsuura fails to teach "finding a dimensional variation . . . of the photo mask," as recited in claim 1. Office Action at page 5. Matsuura only discloses, for example, at col. 3, line 64 through col. 4, line 20, a "test exposure step of transferring identical transfer patterns at a plurality of

positions on the photoresist film . . . by using a test mask . . . [and] calculating a dimensional variation in identical transfer pattern[s]" in order to determine whether the "illumination optical system and the reduction image-forming optical system" needs adjustments. Emphasis added. However, Matsuura fails to teach "finding a dimensional variation . . . of the photo mask," as recited in claim 1.

Park teaches modifying the "degree to which the intensity of illumination" is set. Col. 11, lines 56-60. In addition, Park teaches "measuring critical dimensions of a pattern formed on a wafer." Col. 10, lines 45-48 (emphasis added). However, Park also fails to teach or suggest "finding a dimensional variation . . . of the photo mask," as recited in claim 1 and thus fails to cure this deficiency of Matsuura.

The Examiner supported the rejection under 35 U.S.C. § 103 by contending that the modification of Matsuura based on Park "would have been obvious to one having ordinary skill in the art . . . because any evaluation of the exposure pattern would in effect be an evaluation of the mask pattern that is used in the exposure." Office Action at 5. Applicants remind the Examiner that the prior art reference (or references when combined) must teach or suggest all of the claim elements. See M.P.E.P. § 2143. Matsuura and Park fail to teach a "dimension variation" related to a "photo mask" as required by claim 1. The references, in combination or alone, fail to teach each and every element recited in claim 1 as required to establish a *prima facie* case of obviousness. Accordingly, the Examiner appears to engage in impermissible hindsight in order to reach a finding of obviousness where neither Matsuura nor Park teach or suggest "finding a dimensional variation . . . of the photo mask," as recited in claim 1.

No *prima facie* case of obviousness is established based on Matsuura and Park regarding claim 1, at least because the references, either alone or in combination, fail to teach or suggest each and every element recited in claim 1. Claim 16, though of different scope, recites similar limitations to claim 1. No *prima facie* case of obviousness is established based on Matsuura and Park with respect to claim 16 for similar reasons as claim 1. Claims 2-15 and 17-20 depend from independent claims 1 and 16, respectively, and are allowable at least due to their respective dependence. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-20 under 35 U.S.C. § 103(a).

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



Dated: December 22, 2006

By: 
Richard V. Burgujian
Reg. No. 31,744

Attachments: Terminal disclaimer as provided for under 37 CFR 1.321(c) (3 pages);
a Petition for Extension of Time (1 page); and
Check in the amount of \$250.00.